REMARKS

Claim 1 has been amended. Claims 4-9 have been cancelled. Applicant reserves the right to pursue the original claims and other claims in this application and other applications. Claims 1 and 2 are pending in this application.

Claim 1 was objected to because of informalities identified by the Office Action. Claim 1 has been amended to address the Examiner's concerns.

Claim 9 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 9 has been cancelled.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,631,827) in view of Roberts et al. (U.S. Patent No. 6,401,078) and Soga et al. (U.S. Patent No. 6,304,856). Claims 4-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls et al. in view of Roberts et al. and Soga et al. and further in view of Thiel (U.S. Patent No. 6,321,214). Claims 4-9 have been canceled. Reconsideration with respect to the remaining claims is respectfully requested.

Applicants wish to note that while the claims have been rejected based on the four references identified above (Nicholls et al., Roberts et al., Soga et al. and Thiel), the text of the rejection relies on a reference identified only as Sansone-1. The Office Action did not provide any other identifying information, such as the patent number, for this reference. During a telephone conversation on December 15, 2004, the Examiner identified the "Sansone-1" reference as U.S. Patent Number 5,051,914.

The present invention is directed a method and system for routing and rating the shipment of items. Claim 1 as amended is directed to a planning engine for use in a planning system for planning the shipment of one or more items that comprises "an input module, responsive to a planning request for shipment of the one or more items for which planning is to be performed, for providing a list including each shipment for which planning is to be performed; a load list template builder, responsive to the list including each shipment for which planning is to be performed, for providing a direct load list template including each

item in each shipment; a consolidation module for determining possible consolidations of shipments and providing a consolidated load list template indicating possible consolidations of shipments; a router module, responsive to the direct load list template and consolidation load list template, for determining possible routes for each shipment of the direct load list template and consolidation of shipments of the consolidated load list template and providing the determined possible routes to the direct load list template and consolidated load list template, the router module using business rules to determine each possible route and prioritizing the business rules in case of conflict; a rater module for determining rates for each possible route for each shipment and consolidation of shipments and providing the determined rates for each possible route to the direct load list template and consolidated load list template; a prorater module for determining an apportionment of the costs of the determined rates for a consolidation of shipments among the items included in the consolidated shipments; an analyzer, responsive to the direct load list template, consolidated load list template, and prorater module, for selecting one of the direct load list template and consolidated load list template based on prorated costs for each shipment included in the consolidated shipments and providing a load list based on the selected one of the direct load list template and consolidated load list template indicating a carrier and service for each shipment of the load list template or consolidated load list template; and an output module, responsive to the load list, for outputting the load list indicating a carrier and service for each shipment of the load list template or consolidated load list template."

Nicholls et al. is directed to a logistics management system that facilitates the process of shipping goods by a shipper having a predefined set of shipping requirements via a carrier having a predefined rate structure. There is no disclosure, teaching or suggestion in Nicholls et al. of "a load list template builder, responsive to the list including each shipment for which planning is to be performed, for providing a direct load list template including each item in each shipment as is recited in claim 1. There is also no disclosure, teaching or suggestion in Nicholls et al. of "a consolidation module for determining possible consolidations of shipments and providing a consolidated load list template indicating possible consolidations of shipments" as is recited in claim 1. There is also no disclosure, teaching or suggestion in Nicholls et al. of a router module that provides "the determined possible routes to the direct

load list template and consolidated load list template, the router module using business rules to determine each possible route and prioritizing the business rules in case of conflict" as is recited in claim 1. There is also no disclosure, teaching or suggestion in Nicholls et al. of "a prorater module for determining an apportionment of the costs of the determined rates for a consolidation of shipments among the items included in the consolidated shipments. There is also no disclosure, teaching or suggestion in Nicholls et al. of "an analyzer, responsive to the direct load list template, consolidated load list template, and prorater module, for selecting one of the direct load list template and consolidated load list template based on prorated costs for each shipment included in the consolidated shipments and providing a load list based on the selected one of the direct load list template and consolidated load list template indicating a carrier and service for each shipment of the load list template or consolidated load list template" as is recited in claim 1.

To overcome the above deficiencies, the Office Action relies on the references to Sansone-1, Roberts et al. and Soga et al.

The Office Action contends that Roberts et al. teaches the goal of proper load planning (Col. 2, lines 65 to Col. 3, line 15), and arrives at the conclusion that this discloses a load list template. Applicants respectfully disagree. The text of Roberts et al. relied on in the Office Action is reproduced in its entirety below.

> The load planning data is sent to a load planner or to load planning software and the billing data is sent to a load planner or to load planning software and the billing data is sent to the billing clerk or accounting/billing software application. With this information in the computer system, the customer can now be billed as well as appropriate load planning can be accomplished, so that when the truck driver returns to the terminal the load planning is completed. Thus, each freight shipment can be unloaded from the truck and directly placed on the truck that will be carrying that load to its next destination. Having the load planning accomplished prior to the freight's arrival, reduces the freight turn-around time and freight handling. Additionally, since the load planner knows what freight is on its way to the terminal, fewer delivery trucks will depart with partial loads. Consequently, the trucking company would be able to move the same amount of freight at a lower cost.

Applicants have carefully reviewed the above passage relied upon by the Office Action, and respectfully submit that while Roberts et al. generally discloses load planning and billing, there is no disclosure, teaching or suggestion in the passages cited by the Office

Action of "a load list template builder, responsive to the list including each shipment for which planning is to be performed, for providing a direct load list template including each item in each shipment" as is recited in claim 1. Applicants respectfully submit that there is no disclosure, teaching or suggestion anywhere in Nicholls et al., Roberts et al. or any of the other references of "a load list template builder, responsive to the list including each shipment for which planning is to be performed, for providing a direct load list template including each item in each shipment" as is recited in claim 1 as amended. Applicants respectfully request that the Examiner provide support for the contention that these features are disclosed in Roberts et al.

As noted by the Office Action, neither Nichols et al., Sansone-1 or Roberts et al. disclose, teach or suggest an analyzer, and relies on the reference to Soga et al to overcome this deficiency. Specifically, the Office Action contends that Col. 19, lines 32-55, teaches route planning, and arrives at the conclusion that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nicholls in view of Sansone-1 and Roberts as taught by Soga to cut down the shipping expenses and to have efficient delivery for customers." Applicants respectfully disagree.

The text of Roberts et al. relied on in the Office Action is reproduced in its entirety below.

> Next, the processor 500 retrieves a transport route pattern DB by using the departure store name and arrival store name as the key to determine transport route base stations. In the transport route pattern DB, transport route base stations are registered at intersection points of a matrix of departure store 3110 and arrival store 3120 as shown in FIG. 28. For example, if the departure store is "Sapporo nishiten" and the arrival store is "Fukuoka higashiten", then an entry 3130 will determine that the transport route is Sapporo nishiten--Chitose Kuhkohten--Fukuoka kuhkohten--Fukuoka higashiten. In the event that a base station to which the processor 500 belongs is not included in the thus determined transport route base stations, an erroneous alarm to this effect is delivered to the out put unit 530 (step 2830).

> When a delivery time is designated by the appointed delivery time 1320 obtained in the step 2815, the processor 500 delivers the appointed delivery time, freight number and arrival store name to the output unit 530 (step 2835). In case a special freight class such as "fragile" or "precision machinery and instruments" is indicated by the special freight index 1322, the contents and the freight number are delivered to the output unit 530. By watching the output, the person in charge of work can identify and handle the special freight with ease (step 2840).

Applicants have carefully reviewed the above passage relied upon by the Office Action, and respectfully submit that while Soga et al. generally discloses route planning, there is no disclosure, teaching or suggestion in the passages cited by the Office Action of "an analyzer, responsive to the direct load list template, consolidated load list template, and prorater module, for selecting one of the direct load list template and consolidated load list template based on prorated costs for each shipment included in the consolidated shipments and providing a load list based on the selected one of the direct load list template and consolidated load list template indicating a carrier and service for each shipment of the load list template or consolidated load list template" as is recited in claim 1. Applicants respectfully submit that there is no disclosure, teaching or suggestion anywhere in Nicholls et al., Sansone-1, Roberts et al. or Soga et al., either alone or in any combination, of "an analyzer, responsive to the direct load list template, consolidated load list template, and prorater module, for selecting one of the direct load list template and consolidated load list template based on prorated costs for each shipment included in the consolidated shipments and providing a load list based on the selected one of the direct load list template and consolidated load list template indicating a carrier and service for each shipment of the load list template or consolidated load list template" as is recited in claim 1 as amended. Applicants respectfully request that the Examiner provide support for the contention that these features are disclosed in the references.

There is also no disclosure, teaching or suggestion in Nicholls et al., Sansone-1, Roberts et al., or Soga et al., either alone or in any combination, of a router module for determining possible routes for each shipment of a direct load list template and consolidation of shipments of a consolidated load list template that uses business rules to determine each possible route and prioritizes the business rules in case of conflict as is recited in claim 1.

The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so). The suggestion or motivation has to be to

make the specific structure claimed. A suggestion or motivation to "cut down the shipping expenses and to have efficient delivery for customers" is not a suggestion or motivation for a specific structural implementation. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in a way they were combined by the inventor." ATD Corp. v. Lydall, Inc., 159 F.3d 534, 545 (Fed. Cir. 1998) (emphasis added). No such suggestion or motivation has been provided by the Office Action.

There is no disclosure, teaching or suggestion in any of the references, either alone or in combination, of "a load list template builder, responsive to the list including each shipment for which planning is to be performed, for providing a direct load list template including each item in each shipment as is recited in claim 1. There is also no disclosure, teaching or suggestion in any of the references, either alone or in combination, of "a consolidation module for determining possible consolidations of shipments and providing a consolidated load list template indicating possible consolidations of shipments" as is recited in claim 1. There is also no disclosure, teaching or suggestion in any of the references, either alone or in combination, of a router module that provides "the determined possible routes to the direct load list template and consolidated load list template, the router module using business rules to determine each possible route and prioritizing the business rules in case of conflict" as is recited in claim 1. There is also no disclosure, teaching or suggestion in any of the references, either alone or in combination, of "a prorater module for determining an apportionment of the costs of the determined rates for a consolidation of shipments among the items included in the consolidated shipments. There is also no disclosure, teaching or suggestion in any of the references, either alone or in combination, of "an analyzer, responsive to the direct load list template, consolidated load list template, and prorater module, for selecting one of the direct load list template and consolidated load list template based on prorated costs for each shipment included in the consolidated shipments and providing a load list based on the selected one of the direct load list template and consolidated load list template indicating a

carrier and service for each shipment of the load list template or consolidated load list template" as is recited in claim 1.

Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from these references. The rejection uses impermissible hindsight to reconstruct the present invention from these references. See Ex parte Clapp, 227 U.S.P.Q. 972,973 (Bd. App. 1985) (requiring "convincing line of reasoning" to support and obviousness determination).

For at least the above reasons, Applicants respectfully submit that claim 1 is allowable over the prior art of record. Claim 2, dependent upon claim 1, is allowable along with claim 1.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims of this case are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,

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